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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,860	02/11/2004	Wing Sum Vincent Kwan	29617/PM480A	3897
4743 7590 02/05/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 02/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/776,860

Applicant(s)

KWAN ET AL.

Examiner

Callie E. Shosho

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: 19-22.  
Claim(s) rejected: 1-18, 23 and 24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Callie E. Shosho  
Primary Examiner  
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**Attachment to Advisory Action**

1. Applicant's amendment filed 1/19/07 has been fully considered but the amendment has not been entered given that the amendment raises new issues that would require further consideration and search.

Specifically, the amendment raises new issues that would require further consideration with respect to claims 19-22. In paragraph 8 of the office action mailed 10/19/06, claims 19-22 were objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form including all of the limitations of the base claim.

In response, in the amendment filed 1/19/07, applicants have rewritten claim 19 and claim 21 in independent form. However, the claims do not include all of the limitations of the base claim on which each depends, namely, claim 1 and claim 10, respectively. Specifically, each claim does not include water in the color changing correction fluid. Thus, the claims have not been rewritten in the form that the examiner indicated would be allowable.

Further, the amendment to claims 19 and 21 raises new issues that would require further consideration under 35 USC 112, first paragraph given that claims 19 and 21 are each based on a disclosure which is not enabling. Water critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

It is noted that claim 19 and claim 21 were each amended to delete the recitation of water in the color changing correction fluid. However, the abstract of the present specification discloses that the improved color changing correction fluid is a water-based system. Further, page 4, lines 12-15 of the present specification discloses that an improved color changing

correction fluid includes water as the primary solvent in order to avoid the need for the use of organic solvents. Thus, it appears that the color changing correction fluid of the present invention requires water.

Further, the amendment to each of claim 19 and claim 21 raises new issues that would require further search given that previously each of the claims required method comprising correcting an error with a coating of the color changing correction fluid that included water and a method step wherein the water is evaporated while now the claims as amended do not require water in the color changing correction fluid or evaporation of such water.

Further, the amendment raises new issues that would require further search in light of the amendment to claim 1, claim 10, and claim 23 which each now require that the color changing correction fluid or color changing fluid "changes color upon drying". Given that such limitation was not previously present in claim 1, claim 10, or claim 23, its inclusion would require new searches.

Additionally, it is noted that even *if* the amendment were entered, claims 1-18 and 23-24 would not be allowable over the cited prior art of record, namely, Okada (U.S. 4,170,669), Okada in view of Keeler (U.S. 4,172,604) or Zabiak (U.S. 4,365,035), and Okada in view of Wang (U.S. 5,649,999) and Kawashima (U.S. 4,170,669) (further in view of Keeler and Zabiak).

Applicant argues that Okada disclose marking composition that retains its initial color after application and that it would be contrary to Okada's intended purpose to provide a mark having a color derived from the indicator if the composition were to change color upon drying.

However, while it is agreed that there is no explicit disclosure in Okada that the color changing composition changes color upon drying, it is noted that present claims 1-18 and 23-24 are drawn to color changing correction fluid or color changing fluid, i.e. composition, not method of using the composition. There is no requirement in present claims 1-18 and 23-24 of actually drying the fluid only that upon drying, the fluid changes color.

Given that Okada either alone, or in combination with the other cited prior art of record, disclose color changing composition as presently claimed, i.e. comprising water, 15-60% titanium dioxide, acid or base as presently claimed, and pH indicator, it is clear that the composition would intrinsically change color upon drying.

That is, given that Okada, Okada in view of Keeler or Zabiak, and Okada in view of Wang and Kawashima each disclose fluid comprising water, acid or base identical to that presently claimed, and pH indicator as presently claimed, it is clear that upon drying, the acid or base and water would evaporate thereby causing the fluid to change color.

Applicant argues that it is would be contrary to Okada's purpose to provide ink having a color derived from an indicator if the composition were to change color upon drying.

However, it is noted that the composition of Okada includes a volatilization retarder to decrease the evaporation rate of the composition and prevent quick drying of the composition, and thus, it is agreed that the purpose of Okada is different than that of the present invention, i.e. fluid changing color upon drying. However, while Okada do slow down the drying of the composition, this does not mean that when the composition does dry, it would not change color. That is, while the purpose of, or method of using, the composition in Okada is different than the presently claimed composition, given that the present claims are drawn to composition, i.e. color

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changing fluid, and given that Okada, Okada in view of Keeler or Zabiak, and Okada in view of Wang and Kawashima each disclose composition as presently claimed which would therefor necessarily intrinsically change color upon drying, it is the examiner's position that the prior art of record would meet the requirements of the claims as amended.

Thus, it is the examiner's position that even if the amendment were entered, the rejections of record under 35 USC 102 and 35 USC 103 would remain applicable against claims 1-18 and 23-24.



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CS  
2/1/07